

DISCUSSION OF THE AMENDMENT

Due to the length of the specification herein, Applicants will cite to the paragraph number of the published patent application (PG Pub) of the present application, i.e., US 2006/0035091, when discussing the application description, both in this section and in the Remarks section, *infra*, rather than to page and line of the specification as filed.

New Claims 24-28 have been added. Claims 24-26 are supported at paragraph [0145] of the specification. Claims 27 and 28 are supported in the specification at paragraph [0146].

No new matter is believed to have been added by the above amendment. Claims 1-7 and 9-28 are now pending in the application.

REMARKS

Applicants thank the Examiner for the courtesy extended to Applicants' attorney during the interview held November 12, 2009, in the above-identified application. During the interview, Applicants' attorney explained the presently-claimed invention and why it is patentable over the applied prior art. The discussion is summarized and expanded upon below.

The rejection of Claims 1-7 and 9-14 under 35 U.S.C. § 102(e) as anticipated by US 2004/0024087 (Bruchmann et al), is respectfully traversed.

During the above-referenced interview, the Examiner evinced a belief that modifying the surface of the substrate of the present claims is inclusive of the printing on part of the surface disclosed by Bruchmann et al.

However, Bruchmann et al's liquid printing inks necessarily comprise colorants. The presently-recited surface does not require that color be added to it. Bruchmann et al is concerned with improved adhesion of the printing ink to the print media [0015], not modifying the surface of the print media to become either more hydrophobic or more hydrophilic. Moreover, while Bruchmann et al also discloses hyperbranched polymer-containing lacquers not containing colorants, but these lacquers are employed only in combination with the above-discussed printing inks, either as a primer or as a coating after the printing process [0003].

Claims 10 and claims dependent thereof, as well as Claim 25, are separately patentable. Bruchmann et al does not disclose the process of Claims 10, 27 or 28. A printing ink would not be applied according to the processes of Claim 25.

For all the above reasons, it is respectfully requested that the rejection be withdrawn.

The rejection of Claims 1-7 and 9-23 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement, is respectfully traversed. Applicants

previously pointed out that as cellulose is described as an applicable but not required substrate material in the specification at paragraph [0056], its exclusion complies with the description requirement, citing *In re Johnson*, 558 F.2d 1008, 194 USPQ 187 (CCPA 1977).

During the interview, Applicants' attorney specifically raised the issue of the pertinence of *Johnson*. The Examiner acknowledged that she did not review *Johnson* prior to sending out the present Office Action. Accordingly, if the Examiner believes that *Johnson* is inapposite, then the Examiner should explain why in the next Office Action. Because Applicants were not apprised of the Examiner's treatment of *Johnson*, such an Office Action should not be made "Final."

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 1-7 and 9-23 under 35 U.S.C. § 112, second paragraph, is respectfully traversed. The Examiner finds that the claims are indefinite because the term "wherein the substrate excludes substrates derived from cellulose" is not a positive limitation.

In reply, there is no requirement that claims contain "positive" limitations. The only requirement is that the limitations be definite. While the issue of indefiniteness was not before the court in *Johnson*, nevertheless, it is otherwise clear therefrom that there is nothing inherently improper about a negative limitation. Accordingly, it is respectfully requested that this rejection be withdrawn.

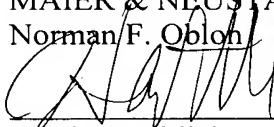
Application No. 10/532,247
Reply to Office Action of October 9, 2008

All of the presently-pending claims in this application are now believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Norman F. Oblon



Harris A. Pitlick
Registration No. 38,779

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 08/07)

NFO:HAP\la